


Referring to the July 7, 1994 Office Action, applicants initially wish to point out a minor error. On page 2 of the Office Action, the Examiner indicates that 17 claims are pending in the application. This is incorrect; there are 19 claims pending.

With respect to the rejections in the Office Action, the Examiner has rejected claims 152-155, 158-161, 168-169 and 174 under 35 U.S.C. §112, first paragraph, alleging that the terms "m", "n", and "p" in the structural formulae of independent claims 167 and 174 render the claims indefinite and nonenabled by the disclosure. In this regard applicants have assumed that claims 167, 170 and 172 were meant to be included in this rejection since claim 167 is discussed in the rejection and claims 170 and 172 dependent from claim 167.

In response applicants wish to point out that the claim language objected to by the Examiner is identical to that of claim 1 of U.S. Patent No. 5,328,824, which issued from U.S. Application Serial No. 07/130,070 on July 12, 1994. The claims of U.S. Patent No. 5,328,824 are directed to methods for using the complexes claimed in the present application. The disclosure of the present application and of U.S. Patent No. 5,328,824 are the same.

Accordingly, by issuing U.S. Patent No. 5,328,824, the Patent Office has made a determination that the claim language being objected to by the Examiner is enabled by the present disclosure. A copy of U.S. Patent No. 5,328,824 is attached hereto for the Examiner's convenience; the attention of the Examiner is specifically directed to claim 1 of the patent and to the disclosure.

Although applicants believe the Examiner's position is incorrect, they have nevertheless amended independent claims 167



and 174 to delete the criticized phrases. In light of the amendments, the above arguments, and the issuance of U.S. Patent No. 5,328,824, applicants request that the Examiner reconsider the rejection under 35 U.S.C. §112 of claims 152-155, 158-161, 168-169 and 174.

The Examiner has also rejected claims 152-155, 158-161 and 164-174 under 35 U.S.C. §112, first and second paragraphs. The Examiner alleges that the descriptions of moiety "A" and its attachments are indefinite because their scopes are too vast and exceed the specific embodiments of the disclosure.

Again applicants direct the Examiner's attention to the newly issued claims of U.S. Patent No. 5,328,824. Claim 1 of this patent contains definitional language for moiety A essentially the same as the language in the present application. The issuance of U.S. Patent No. 5,328,824 clearly illustrates that the language defining moiety A meets the statutory requirements for definiteness under 35 U.S.C. §112.

Additionally, as pointed out in applicants' last response, notices of allowance for other U.S. applications concerning hybridization probes have been issued wherein the definition of the signalling moiety is broader than the definition of moiety 'A' of the present application. For example, the present definition of moiety 'A' is narrower than the definition for the signalling moiety in U.S. Serial No. 07/532,704, which issued as U.S. Patent No. 5,241,060 on August 31, 1993. (See independent claim 1 wherein the SIG moiety is defined as "a detectable moiety".) The issuance of this patent also provides evidence of the definiteness of the present description for moiety 'A' and its fulfillment of the statutory requirements under 35 U.S.C. §112.

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It is well-established that there is no need for exhaustive examples in the specification to satisfy the requirements of 35 U.S.C. §112. It is only necessary that there be no undue experimentation. Lindemann Maschinenfabrik v. Am. Hoist and Derrick, 730 F.2d 1452, 1463 (Fed. Cir. 1984). Even in an unpredictable art -- which the present invention is not -- 35 U.S.C. §112 does not require disclosure of a test with every species covered by a claim. Accordingly, applicants are not, and should not be, required to set forth each and every label that can be used as moiety "A" in the practice of the invention. That teaching is available in the art in light of the instant disclosure.

Accordingly, in light of the arguments presented herein and the issuance of U.S. Patent No. 5,328,824, applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §112 and allow the application.


If a telephone conference would be of assistance in furthering the prosecution of the subject application, applicants' undersigned attorney requests that he be contacted at the number provided.

No fee is deemed necessary in connection with the filing of

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this Amendment, other than the fee for a three-month extension of time. If any other fee is required, authorization is hereby given to charge the amount of any such fee to deposit account no. 12-1325.

Respectfully submitted,


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I hereby declare that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231

1/9/95
Date


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